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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,900	03/22/2004	Dirk Fischer	LA-7004-101C1/10404534	2399
167	7590	11/17/2005	EXAMINER	
FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 11/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,900

Applicant(s)

FISCHER ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/530809.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. The Examiner notes that the Drawings in their present form are clearly informal, although acceptable for purposes of examination. It is further noted that the Continuation data in Paragraph No. 0001 of the specification should be updated with respect to the abandoned status of parent application 09/530,809. Additionally, Paragraph No. 0015 should remove all references to the cited claims, preferably with a recitation of the subject matter contained in these claims as originally filed.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, quite a few informalities are present in the claims and the Examiner will attempt to point out as many as possible, although some may be overlooked and applicants are requested to correct any such oversights. Initially it is noted that in all of the dependent claims, whether process or article, the reference only to "the improvement", by itself, instead of either the method or the card, i.e. the article, is clearly improper. It is further noted that several of the dependent claims improperly have multiple dependent claim(s) dependent upon themselves such as claims 4, 9 and 20; the claims which are improperly dependent upon such a claim are 15, 20, 24, and 29. It is further noted that each of applicants' independent claims can have the presence of at least two adhesive layers, but all of applicants' dependent claims refer improperly only to "the thermoplastic adhesive

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coating". Additionally, the reference to the adhesive coating which is defined as "has a surface roughness" is clearly vague and indefinite.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA 0 348 349 (Smith et al is cumulative) taken in view of applicants' admissions in the Jepson claim preambles of independent claims 1 and 6. Note particularly the Abstract, page 2, lines 5-19, page 4, lines 51-63, page 5, lines 52-63page 5, lines 5-23, Example 1. Note that applicants' claims significantly differ only from the parent application only in two significant aspects; namely that they specifically claim a thermoplastic polymer adhesive and further state that the resulting adhesive layer is in direct contact with each of the covering layers, whereas the reference appears to utilize a thermoplastic adhesive such as an acrylate but does not expressly state that it is a thermoplastic (as opposed to thermosetting) composition. As to the direct contacting limitation the reference teaches the presence of a gelatin layer between each pair of contacting core-covering layer structures. However, the Examiner further notes that applicants have admitted by putting each of these two newly presented limitations in their Jepson claim preambles that each of these structures are known in the art, and accordingly the Examiner believes that he is fully justified in combining these admitted teachings with the disclosure of EPA'349 to reject applicants' claims. Note also that the reference

clearly teaches the improvement section of the Jepson claims by disclosing the presence of a silica filler (e.g. Example 1), which is essentially all the broad claims are believed to require. With respect to the nominal method steps, as well as the various particle fillers that provide friction, as well as the specific ranges of amounts, the layer thicknesses and the surface roughness of the adhesive coating are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Patzold et al, Koning et al, and Neuhaus et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style, with the first letter of each word being capitalized and prominent.